

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW MARSHALL
and
JOSEPH DEVORE

Appeal No. 1996-0427
Application 08/210,224¹

ON BRIEF

Before JERRY SMITH, FLEMING and GROSS, **Administrative Patent Judges**.

¹ Application for patent filed March 17, 1994.

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FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 5, 10 through 14, and 19 through 21. Claims 6 through 9, 15 through 18 and 22 through 24 are objected to.

Appellants' invention relates generally to power supply circuits and, more particularly, to a switch-mode power regulator including apparatus for providing a controlled turn-on.

Independent claim 1 is reproduced as follows:

1. Apparatus for use in a power regulator, said apparatus providing a controlled turn on of said power regulator, said apparatus comprising:

means responsive to an initiation of turn on of said power regulator for generating a signal comprising a sequence of a predetermined number of pulses, said pulses increasing in length monotonically during said sequence; and

means responsive to said signal for enabling current flow through said power regulator for the durations of each of said pulses.

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The reference relied on by the Examiner is as follows:

Yamamura et al. (Yamamura)	5,233,508	Aug. 3,
1993		

Claims 3, 12 and 21 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. Claims 1, 2, 5, 10, 11, 14, 19 and 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Yamamura. Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamamura.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the brief and the answer for the details thereof.

OPINION

After a careful review of the evidence before us, we agree with the Examiner that claims 1, 2, 5, 10, 11, 14, 19

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and 20 are properly rejected under 35 U.S.C. § 102 and claims 4 and 13 are properly rejected under 35 U.S.C. § 103. However, we do not agree with the Examiner that claims 3, 12 and 21 are properly rejected under 35 U.S.C. § 112, second paragraph. Thus, we will sustain the rejection of claims 1, 2, 4, 5, 10, 11, 13, 14, 19 and 20, but we will reverse the rejection of claims 3, 12 and 21 on appeal for the reasons set forth *infra*.

Turning to the rejection of claims 3, 12 and 21 under 35 U.S.C. § 112, second paragraph, the Examiner argues on page 3 of the answer that these claims are indefinite because it is not

correct to recite "said signal continues to pulse between said first voltage and said second voltage level following said sequence." Appellants argue on page 8 of the brief that the phrase has antecedent basis in "means responsive to an initiation of turn on of said power regulator for generating a signal comprising a sequence of a predetermined number of

pulses, said pulses increasing in length monotonically during said sequence." On page 9 of the brief, Appellants argue that this claim language is definite when read in light of the specification on pages 9, 10 and 13 and in light of the structure shown in Figure 5.

Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether claims set out and circumscribe the particular area with a reasonable degree of precision and particularity; it is here where definiteness of the language must be analyzed, not in a vacuum, but always in light of teachings of the disclosure as it would be interpreted by one possessing ordinary skill in the art. ***In re Johnson***, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977), ***citing In re Moore***, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. § 102 rather than under 35 U.S.C. § 112,

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second paragraph. **See *In re Hyatt***, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) citing ***In re Borkowski***, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970).

Upon our review of the Appellants' specification and Figure 5, we find that the claim language "said signal continues to pulse between said first voltage and said second voltage level following said sequence" sets out and circumscribes the particular area with a reasonable degree of precision and particularity. Therefore, we will not sustain the rejection of claims 3, 12 and 21 under 35 U.S.C. § 112, second paragraph.

Claims 1, 2, 5, 10, 11, 14, 19 and 20 stand rejected under 35 U.S.C. § 102 as being anticipated by Yamamura. At the outset, we note that Appellants state on pages 6 and 7 of the brief four groups that stand or fall together. We note that Appellants set forth the same argument for claims 1, 2, 5, 10, 11, 14, 19 and 20 in the brief. 37 CFR § 1.192(c)(7) (July 1, 1995) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellants' filing the brief, states:

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For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a

single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Since Appellants have provided the same argument for claims 1, 2, 5, 10, 11, 14, 19 and 20, we will, thereby, consider the Appellant's claims 1, 2, 5, 10, 11, 14, 19 and 20 as standing or falling together and we will treat claim 1 as a representative claim of the group.

On page 12 of the brief, Appellants argue that Yamamura fails to teach or suggest "means responsive to an initiation of turn on of said power regulator for generating a signal comprising a sequence of a predetermined number of pulses." Appellants argue that the predetermined number of

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pulses as claimed are provided by the structure disclosed in the specification and that these elements as selected and interconnected provide the number of pulses during any turn on sequence which will be invariant regardless of the variations in the frequency of the clock signal or variations in the level of

the voltage supplied to the apparatus providing controlled turn on of the power regulator. Appellants further argue that Yamamura provides pulses as a function of the rise time of V1 and the amplitude of saw tooth voltage ST, thereby Yamamura fails to teach "a sequence of predetermined pulses" as claimed by Appellants.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference

discloses, expressly or under principles of inherency, each and every element of a claimed invention." **RCA Corp. v.**

Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), **cert. dismissed**, 468 U.S. 1228 (1994), **citing Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

Returning to Yamamura, we note as shown in Figure 3 that Yamamura produces a P1 signal which reads on Appellants' claim language as recited in claim 1. In particular, Yamamura's P1 is "a signal comprising a sequence of predetermined number of pulses, said pulses increasing in length monotonically during said sequence" as recited in Appellants' claim 1. Turning to Figure 2, Yamamura discloses that apparatus 10 provides the saw tooth signal ST as shown in Figure 3. Figure 2 shows that the saw tooth signal ST is provided to operational amplifier 22 and that apparatus 20 provides the signal P1 for the period of time until V1, which is the charge voltage of capacitor 26, exceeds the voltage of the saw tooth signal. We note that Yamamura teaches that

these signals do not vary. In particular, apparatus 10 provides an invariant saw tooth signal once the values of the elements of the apparatus are selected and inter-connected. Furthermore, the voltage charging of the capacitor is also set when the value of the capacitor is selected and interconnected. Thereby, the time period for when the voltage V1 exceeds the voltage of the saw tooth is set and predetermined. Thus, the apparatus as shown in Figure 2 does provide a sequence of predetermined number of pulses as claimed by Appellants. Therefore, we will sustain the Examiner's rejection of claims 1, 2, 5, 10, 11, 14, 19 and 20 under 35 U.S.C. § 102.

Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as

being unpatentable over Yamamura. On pages 15 and 16 of the brief, Appellants argue that the arguments presented for claim 1 apply equally to claims 4 and 13. Appellants do not present any further argument. We have addressed the argument for claim 1 and have found that Yamamura teaches the limitations

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of providing a signal comprising a sequence of a predetermined number of pulses. Therefore, we will sustain the Examiner's rejection of claims 4 and 13 under 35 U.S.C. § 103.

We have addressed all of Appellants' arguments. We are not required to raise and/or consider any further issue not argued by Appellants. As stated by our reviewing court in *In re Baxter Travenol Labs.*, 952 F.2d 388, 391, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991), "[i]t is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art." 37 CFR § 1.192(a)(July 1, 1995) **as amended at** 60 Fed. Reg. 14518 (March 17, 1995), which was controlling at the time of Appellants filing the brief, states as follows:

The brief . . . must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

37 CFR § 1.192(c)(8)(iii) states:

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For each rejection under 35 U.S.C. § 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. § 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Also, 37 CFR § 1.192(c)(8)(iv) states:

For each rejection under 37 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

Thus, 37 CFR § 1.192 provides that this board is not under any greater burden than the court which is not under any burden to raise and/or consider issues not argued by Appellants.

In view of the foregoing, the decision of the

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Examiner rejecting claims 1, 2, 4, 5, 10, 11, 13, 14, 19 and
20 is

affirmed; however, the decision of the Examiner rejecting
claims 3, 12 and 21 is reversed.

No time period for taking any subsequent action in
con- nection with this appeal may be extended under 37 CFR §
1.136(a).

AFFIRMED-IN-PART

	JERRY SMITH)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
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	Administrative Patent Judge)	
INTERFERENCES)	
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